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Subject: U.S. Trademark Application Serial No. 88646255 - GUNTHER'S - 21017.006 - EXAMINER BRIEF

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United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 88646255

Mark: GUNTHER'S

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Applicant: Gunther's Quality Ice Cream, Inc.

Reference/Docket No. 21017.006

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act of 1946 (as amended) (hereinafter "the Trademark Act"), 15 U.S.C. §1052(d).

FACTS

Applicant has applied for registration on the Principal Register for the mark “GUNTHER’S” in standard characters for “Ice cream; Non-dairy frozen confections” in class 30 and “Restaurant services featuring ice cream and non-dairy frozen confections, namely, frozen dessert parlors” (as amended) in class 43. Registration was refused under Trademark Act Section 2(d), 15 U.S.C. 1052(d), based on likelihood of confusion with the following two registered marks as to be likely to cause confusion or to cause mistake or to deceive :

1. Registration No. 4556314 for the mark “GUNTHER’S GOURMET” in standard characters for use with respect to “sauces” in class 30.
2. Registration No. 1435063 for the mark “GUNTHER TOODY’S” in standard characters for use with respect to “restaurant services” in class 42.

This appeal follows the Examining Attorney’s final refusal under Section 2(d).

ISSUES ON APPEAL

There are two issues on appeal:

Issue One: Whether applicant’s mark so resembles the registered mark GUNTHER’S GOURMET, when used in connection with their respective identified goods, as to be likely to cause confusion under Section 2(d) of the Trademark Act.

Issue Two: Whether applicant’s mark so resembles the registered mark GUNTHER TOODY’S, when used in connection with their respective identified services, as to be likely to cause confusion under Section 2(d) of the Trademark Act.

ARGUMENT – ISSUE ONE

I. APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION WITH THE REGISTERED MARK
"GUNTHER'S GOURMET" WHEN USED IN CONNECTION WITH THE SPECIFIED GOODS

Applicant's mark makes a very similar commercial impression to registrant's mark and, when combined with the relatedness of the associated goods, is likely to cause confusion in consumers who are likely to mistakenly believe that applicant's goods and registrant's goods come from the same source or are affiliated services from the same entity in each instance.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "*du Pont* factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, "not all of the *DuPont* factors are relevant or of similar weight in every case." *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the

cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

A. The Marks Provide a Similar Commercial Impression

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Applicant's mark deletes the wording "GOURMET" from the registration "GUNTHER'S GOURMET". Although applicant's mark does not contain the entirety of the registered mark, applicant's mark is likely to appear to prospective purchasers as a shortened form of registrant's mark. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting *United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985)). Thus, merely omitting some of the wording from a registered mark may not overcome a likelihood of confusion. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257; *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). In this case, applicant's mark does not create a distinct commercial impression from the registered mark because it contains some of the wording in the registered mark and does not add any wording that would distinguish it from that mark.

Looked at another way, the additional term "GOURMET" in the "GUNTHER'S GOURMET" registration does not sufficiently differentiate the marks because this wording is descriptive and has been disclaimed. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for a party's goods and/or services – in this case, "GOURMET" – is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii).

Moreover, each of these marks begin with the wording "GUNTHER'S". Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks

in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”).

Applicant argues that the additional word “GOURMET” is “significant,” notes that the registration has more syllables and vowels as has the applied-for mark, and points to a definition provided by the Merriam-Webster.com Dictionary:

“Gourmet” is defined as “of, relating to, or being high quality, expensive, or specialty food typically requiring elaborate and expert preparation,” Gourmet, Merriam-Webster.com Dictionary. Exhibit 1 attached.¹ Consumers seeking “gourmet” food are understood to be more discerning regarding the source of the desired goods and services and thus less likely to be confused as to source. The “GOURMET” element of the registered mark has significant weight, especially due to the mnemonic alliteration discussed above.

The Examining attorney does not agree, and again notes that the word in common here, GUNTHER’S, “is likely to appear to prospective purchasers as a shortened form of registrant’s mark.” Of course, all shortened forms of all marks are apt to have fewer syllables and vowels than the mark they shorten. Consumers don’t keep running tallies of either. As to the difference in meaning, a consumer is alternatively apt to regard the registered mark as signaling a higher level of product quality from the

same source, rather than regard goods sold under the “GUNTHER’S GOURMET” trademark as coming from a wholly different source. The registrant’s additional word “GOURMET”, as it is so descriptive as to have been disclaimed, has little to no separate source-indicating power here.

For the foregoing reasons, the marks are confusingly similar.

B. Applicant’s Goods are Related to the GUNTHER GOURMET’S Mark’s Goods

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Applicant’s goods are various frozen confections, namely, ice cream and non-dairy frozen confections, and the pertinent goods in the GUNTHER’S GOURMET registration are sauces. (This registration lists other goods as well, such as salad dressing, but this refusal has never been based on them.) As is further discussed below, these goods are related because consumers often encounter them under a single mark, and because they are often used together.

The previously attached Internet evidence of record consists of screenshots of products from the websites of Ghirardelli’s, The New York Times, Duo.com, Fine Dining Lovers, Taste of Home and Food Network establishes that the same entity commonly manufactures/produces/provides the relevant goods and markets the goods under the same mark for sale through the same trade channels and that

these are used by the same classes of consumers in the same fields of use, and that sauces and frozen confections, dairy or not, are complementary in terms of use. Thus, applicant's and the GUNTHER'S GOURMET'S registration's goods are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

For example, evidence submitted with the Office Action of January 21, 2020 includes screenshots taken from Ghirardelli.com that show Ghirardelli offers both ice cream and sauces as toppings for its ice cream under its mark ("Ghirardelli sauces are exceptional for topping desserts, ice cream, and frozen yogurt...Ghirardelli sauces are made with real chocolate, caramel, and cocoa butter for intense flavor" – see page 11). More generally, a screenshot taken from the New York Times cooking section shows the intimate relationship between ice cream and sauces ("Ice Cream Sauces and Toppings" – see page 8).

The goods in the GUNTHER'S GOURMET registration relied on here are registrant's "sauces," but applicant argues that those goods should be read in conjunction with all of the other goods listed, which are presented by applicant as follows: "The goods of the cited registration are marinades, vinaigrettes, salsa, salad dressings, and sauces." The applicant then goes on to argue that "sauces" must refer back to salsa and salad dressing, which one would not ordinarily think to put on ice cream.

In applicant's presentation of these goods, it appears that "sauces" is simply the last in a list of related items, all separated by commas. However, the registration actually separates the word "sauces" from the other goods via a semicolon:

Class 30: Marinades, vinaigrettes, salsa, salad dressings; sauces

Thus, “sauces” is to be read as separate from “marinades, vinaigrettes, salsa, salad dressings,” which are separated from each other by commas and not semicolons. Whatever the suitability or relatedness of salsa or salad dressings to ice cream, they should not be read to characterize the registrant’s “sauces.”

Applicant goes further here, and argues that its interpretation is correct based on specimens submitted in connection with the GUNTHER’S GOURMET registration:

The specimens submitted in connection with the GUNTHER’S GOURMET registration depict salsa sauces and savory sauces: “crab salsa,” “lime mango salsa,” “tropical style mango salsa,” “pineapple orange hot sauce,” and “orange balsamic vinaigrette & marinade”.

However, when analyzing an applicant’s and registrant’s goods and/or services for similarity and relatedness, that determination is based on the description of the goods and/or services in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

To recapitulate, the registration was cited for “sauces,” and the close relationship between confectionary treats such as ice cream and the registration’s sauces has been well established by the evidence of record.

Applicant’s mark GUNTHER’S creates a confusingly similar impression to that of the GUNTHER’S GOURMET registered mark based on the identical wording of the dominant portion of the respective marks, as well as the close relatedness of treats such as applicant’s ice cream and the registrant’s sauces, including the likelihood that consumers would find both offered under the same mark together and often in the same venue (e.g., an ice cream parlor). Thus, based on the high similarity of the marks,

the intimate relatedness of the goods (literally as close as that of a tasty chocolate sauce poured onto a scoop of cold ice cream on a hot day), consumers are likely to mistakenly believe that the goods provided under the applied-for mark and under registrant's mark come from the same source.

For the foregoing reasons, the trademark examining attorney respectfully requests that the refusal based on Section 2(d) of the Trademark Act be affirmed.

ARGUMENT – ISSUE TWO

I. APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION WITH THE REGISTERED MARK "GUNTHER TOODY'S" WHEN USED IN CONNECTION WITH THE SPECIFIED SERVICES

Applicant's mark makes a very similar commercial impression to registrant's mark and, when combined with their legally identical associated services, is likely to cause confusion in consumers who are likely to mistakenly believe that applicant's services and registrant's services come from the same source or are affiliated services from the same entity in each instance.

As noted above, Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "*du Pont* factors"). Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services.

C. The Marks Provide a Similar Commercial Impression

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797

Where the services of an applicant and registrant are identical or virtually identical, as is the case here (registrant’s “restaurant services” encompass applicant’s class 43 restaurant services), the degree of similarity between the marks required to support a finding that confusion is likely declines. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterro Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(b).

The mark in the 1435063 registration is “GUNTHER TOODY’S”, whereas the applied-for mark is “GUNTHER’S”. Thus, the ending of the wording in the applied-for mark includes an apostrophe followed by the letter “S”, whereas such is absent from GUNTHER in the 1435063 registration. This additional matter has little, if any, trademark significance and does not otherwise affect the overall similarity of the marks in terms of commercial impression. *See In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (noting that “[t]he absence of the possessive form in applicant’s mark . . . has little, if any, significance for

consumers in distinguishing it from the cited mark”); *In re Curtice-Burns, Inc.*, 231 USPQ 990, 992 (TTAB 1986) (finding the marks MCKENZIE’S and MCKENZIE “virtually identical in commercial impression”); *Winn’s Stores, Inc. v. Hi-Lo, Inc.*, 203 USPQ 140, 143 (TTAB 1979) (noting that “little if any trademark significance can be attributed to the apostrophe and the letter ‘s’ in opposer’s mark”).

Applicant’s mark deletes the wording “TOODY’S” from the 1435063 registration. Although applicant’s mark does not contain the entirety of the registered mark, applicant’s mark is likely to appear to prospective purchasers as a shortened form of registrant’s mark. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting *United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985)). Thus, merely omitting some of the wording from a registered mark may not overcome a likelihood of confusion. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257; *In re Optica Int’l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). In this case, applicant’s mark does not create a distinct commercial impression from the registered mark because it contains some of the wording in the registered mark and does not add any wording that would distinguish it from that mark.

Each of these marks begin with the wording GUNTHER (with or without an apostrophe followed by the letter “S”). Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir.

2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”).

Applicant raises a number of arguments against the refusal, beginning with an assertion of absence of actual confusion with the registered marks:

There has been no actual confusion with the GUNTHER TOODY’S mark or the GUNTHER’S GOURMET mark and, prior to reference to these registered marks by the Office, the CEO of Applicant had never heard of the registered marks or their owners. Klopp Declaration, ¶¶ 5, 6.

However, “[A] showing of actual confusion is not necessary to establish a likelihood of confusion.” *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); TMEP §1207.01(d)(ii). “[T]he relevant test is *likelihood* of confusion, not *actual* confusion.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 1309, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018) (emphasis in original). “Uncorroborated statements of no known instances of actual confusion . . . are of little evidentiary value,” especially in ex parte examination. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

Applicant also argues that the Examining attorney has not applied the proper standard in his analysis:

The refusal to register is based on the Office’s assumption of what consumers “may” or “might” do when exposed to the marks (e.g., “GUNTHER’S may still be taken for an

abbreviated reference to the registration.” Aug. 27, 2020 Final Office Action, TSDR p. 4).

Respectfully, this is not the standard.

Reviewing the entire office action, it is clear that by and large, direct wording such as “is likely” is used almost throughout, reflecting the (correct) standard that has guided this analysis.

Applicant argues that the additional word “TOODY’S” is “significant,” and notes that the registration has more syllables and vowels as the applied-for mark. The Examining attorney again notes that the word in common here, GUNTHER, “is likely to appear to prospective purchasers as a shortened form of registrant’s mark.” Of course, all shortened forms of all marks are apt to have fewer syllables and vowels than the mark they are shortening. Consumers don’t keep running tallies of either. The presence of the possessive form for “GUNTHER’S” simply shifts it from “TOODY’S” as is consistent with the former being a shorthanded way of referring to the latter.

Applicant argues that the registered mark refers to a fictional character from the early sixties television program “*Car 54 Where Are You?*” and argues that this character provides the commercial impression of the mark, including providing a theme for restaurants operating under the registered mark. Whether “GUNTHER TOODY’S” is or is not understood to refer to a fictional character from a long-gone television series, consumers are apt to regard “GUNTHER’S” as simply being an abbreviated shortened version of “GUNTHER TOODY’S” especially since the name “GUNTHER” appears at the start of both marks, as is common for a given name.

Applicant provides further comments relating to a name refusal previously made, however, that refusal was withdrawn, and is not relevant here.

For the foregoing reasons, applicant’s mark is confusingly similar to the registered mark.

D. The Services of These Marks Are Legally Identical

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, the registration GUNTHER TOODY'S uses broad wording to describe "restaurant services," which presumably encompasses all services of the type described, including applicant's more narrow "Restaurant services featuring ice cream and non-dairy frozen confections, namely, frozen dessert parlors." *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant's and registrant's services are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

When analyzing an applicant's and registrant's goods and/or services for similarity and relatedness, that determination is based on the description of the goods and/or services in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

In this case, the services in the application and registration are legally identical. Therefore, it is presumed that the channels of trade and class(es) of purchasers are the same for these goods and/or services. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). Moreover, as

the Internet evidence appended to the April 7, 2021 response to applicant's Request for Reconsideration (consisting of screenshots from the websites of McDonalds, Burger King, and Pop's Ice Cream Co.) demonstrates, restaurants often serve frozen confections, and frozen dessert parlors often serve other food items.

Applicant's mark creates a confusingly similar impression to that of the GUNTHER TOODY'S registrant's mark based on their shared initial wording "GUNTHER", with the addition of a possessive form to further make it appear to be a shortened reference to the registered mark. That, combined with their legally identical services, make these marks confusingly similar.

Applicant's mark GUNTHER'S creates a confusingly similar impression to that of the GUNTHER TOODY'S registered mark. Thus, based on the high similarity of the marks and their legally identical services, consumers are likely to mistakenly believe that the services provided under the applied-for mark and under registrant's mark come from the same source.

For the foregoing reasons, the trademark examining attorney respectfully requests that the refusal based on Section 2(d) of the Trademark Act be affirmed.

CONCLUSION

For the foregoing reasons, the trademark examining attorney respectfully requests that the refusals based on Section 2(d) of the Trademark Act with respect to both the GUNTHER'S GOURMET and the GUNTHER TOODY'S marks be affirmed.

Respectfully submitted,

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